UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,025	04/12/2001	Yoshiyasu Kubota	SONYJP 3.0-154	5235

7590	06/04/2004

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EXAMINER
SCHNEIDER, JOSHUA D

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)	
Office Action Summary	09/834,025	KUBOTA, YOSHIYASU	
	Examiner	Art Unit	
	Joshua D Schneider	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 10-19* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 10-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

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PRIMARY EXAMINER
GROUP 2100

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some *   c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 1/12/2004 has been entered.

Response to Arguments

2.   Applicant's arguments filed 1/12/2004 have been fully considered but they are not

persuasive. Applicant has argued that the Chew reference does not include the reader unit

requesting action by the memory card. Applicant further argues that the action is that of the

memory card requesting action from the reader. This conclusion reached by the applicant is

directly contradicted by column 6, lines 10-36 of Chew. In the sentence starting on line 16,

Chew teaches that the operating system, of the memory card, waits for a command from the

reader. The command is then checked for validity. If valid, the transaction proceeds. If invalid,

an error status is returned to the reader unit and the card again waits for another command from

the reader unit. This is the same action as in the claims of the instant application, and as taught

in the specification, for the detection of a memory function (paragraphs 28-31 and 48). It is

therefore impossible to successfully argue that Chew somehow does not teach a request by the

reader unit for action by the memory card, or that Chew teaches away from the claims.

3.   The argument that the reader operates transparently to the memory card is erroneous, and

when the reference is properly interpreted the citations are clearly irrelevant to the teachings of

the instant application. All of the citations make clear that it is only the processing of the

functions that are done in a transparent manner. That is, any actual calculations, such as adding

or subtracting value, are done entirely in the card. This is made clear when the cited passage is

read in its entirety (column 5, line 13, through column 6, line 9). It is abundantly clear that the

detection and the actual processing of functions are not equivalent operations. Applicant is

reminded to use the reference as a whole to fully understand the teachings of the reference, and

not rely on single sentences without the surrounding context. To say that the memory card is in

control of the operations of the system is to ignore the teachings of column 5, lines 10-36, which

makes clear that while the card is in charge of carrying out the orders, the reader is in charge of

giving them.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1-7 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent 5,901,303 to Chew. With regards to claims 1, 6, 11, and 16, Chew teaches providing

a removably connected electronic device (smart card), having a register (memory), having a

write area and a read area (Fig. 1, and column 4, lines 53-64). The card performs startup

processes and then receives a command from the main unit (reader, column 6, lines 14-21).

Chew does not explicitly distinguish a read and a write area of a register. However, it would

have been obvious to one of ordinary skill in the art at the time of invention that the RAM

memory acts as a writing area when the card receives commands for processing, and that the

reading area could be embodied in either data buffered in the RAM or data in either ROM or

programmable memory as was well known in the art. It is inherent to Chew that the requested

function is written into the write area of the register (RAM) when the command is processed

(column 6, lines 19-21). This must be the case for the card to recognize the command requested

by the reader. Chew then teaches the reading of a code of a function (column 6, lines 19-21 and

26-27, and column 4, line 63, though column 5, line 5), and a code associated therewith (column

5, lines 5-12). Chew also teaches detection of a requested function by the main reader unit

(column 4, lines 19-25 and column 6, lines 22-23). The reader reads the status code for the

function to ascertain validity of the command sent from the reader to the card operating system.

6.   With regards to claims 2, 7, 12, and 17, Chew teaches a list of codes of the functions

(column 6, lines 19-21), and a code associated therewith (column 5, lines 5-12). Chew does not

explicitly teach the list being at a predetermined address. It would have been obvious to one of

ordinary skill in the art at the time of invention that the list of codes of the functions would have

to have been at a predetermined address for it to be accessed by the card operating system and

the reader (column 6, lines 19-28).

7.   With regards to claims 3 and 13, Chew teaches the determination of a function to be

executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27).

8.   With regards to claims 4 and 14, Chew teaches the determination of a function to be

executed after accessing the list at the predetermined address (column 6, lines 19-21 and 26-27).

Chew teaches a list of codes of the functions (column 6, lines 19-21), and a code associated

therewith (column 5, lines 5-12). Chew does not explicitly teach the list being at a

predetermined address. It would have been obvious to one of ordinary skill in the art at the time

of invention that the list of codes of the functions would have to have been at a predetermined

address for it to be accessed by the operating system (column 6, lines 19-21).

9.   With regards to claims 5, 10, and 15, Chew teaches the enablement of the execution of a

function after the determination (column 6, lines 26-27).

10.   Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 5,901,303 to Chew as applied to claims 1-7 and 10-17 above, and further in view of U.S.

Patent 6,574,677 to Song et al. Chew fails to teach the activation of a driver and the driver

enabling the function to be executed. Song teaches the use of a driver for the configuration of

the communication method to enable the use of a smart card (column 2, lines 18-25). The use of

drivers to establish communication with storage media in media reading devices is common in

the art. It would have been obvious to one of ordinary skill in the art at the time of invention to

combine the function determination of Chew with the driver enablement of Song to create a

reader that can properly interface with media cards in a safe, secure, and reliable manner.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991.

The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDS

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